REMARKS

Summary of the Final Office Action

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Publication JP-A-10-009235 to Atsuyoshi et al. ("*Atsuyoshi*") in view of JP-A-7-165256 to Seiji ("*Seiji*") and JP-A-8-199123 to Akira et al. ("*Akira*") and further in view of U.S. Patent 4,791,014 to West[1] ("*West*"), U.S. Patent 6,626,294 to Fujishima et al. ("*Fujishima*"), and U.S. Patent 2,743,445 to Lerner ("*Lerner*").

Summary of the Response to the Final Office Action

Applicant has amended claims 1 and 9. Claims 1-9 are pending.

The Rejections under 35 U.S.C. § 103(a)

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Atsuyoshi* in view *Seiji* and *Akira* and further in view of *West*, *Fujishima*, and *Lerner*. Applicant respectfully traverses the rejections for at least the following reasons.

Applicant respectfully asserts that independent claim 1, which has been amended to incorporate some of the features of original claim 9, is allowable over the art of record. The Final Office Action does not address why claim 9 is rejected. Applicant submits that the rejection must be withdrawn in the absence of a rationale. *See* MPEP § 2142 ("The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v.*

[1] The Final Office Action refers to U.S. Patent 4,791,014 as being to "Libby." However, West is the inventor for this patent. Also, in paragraph 4, the Final Office Action discusses "Libby '856" while, presumably, the Final Office Action is discussing U.S. Patent 4,791,014. The Applicant assumes all discussion of "Libby" or "Libby '856" in the Final Office Action is intended to refer to U.S. Patent 4,791,014 to West.

Teleflex Inc., 550 U.S. ___,____, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit."). Nevertheless, in an effort to expedite prosecution, Applicant states the following.

First, although the Office Action fails to clearly set forth which rationale is used to support the finding of obviousness, Applicant believes the Office Action may be relying on Rationale E – "Obvious to Try." *See* MPEP § 2143(E). To reject a claim based on this rationale, the Office Action must state, among other things, "a finding that at the time of the invention there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem." MPEP § 2143(E). Applicant submits that the Office Action has failed to make such a finding.

Second, the arrangement of the tearable film only at a potion of the staple member corresponding to an innder side of crown portion of a C-shape staple is not merely a design choice, but is a choice made according to advantages. *See* MPEP § 716.02(f). As disclosed on page 6, line 21 – page 7, line 8 of the specification, such an arrangement allows to the film to be made inconspicuous by being pinched between the top potion and the sheet to be bound.

Third, the Final Office Action's reliance on *West* is misplaced. The Final Office Action alleges that *West* "discloses that it's well known in the art to provide the film adhered on the side of the staple that will become the inside portion of the bridge portion of the C-shape staple." Applicant respectfully disagrees. Applicant can find no support in *West* for this assertion, and the Final Office Action provides none. Instead, *West*, at most, discloses providing a tape on the crowns of connected clips. *See, e.g.*, Figs. 1-3.

Fourth, the Final Office Action's reliance on *Fujishima* is misplaced. The Final Office Action alleges that Figs. 4 and 6 of *Fujishima* "illustrate the film to be applied to the side of the staple that will become the inside of the C-shape staple." Applicant respectfully disagrees. Applicant assumes the Final Office Action alleges pulling out tape 12 of *Fujishima* is a tearable film as claimed. Applicant respectfully disagrees. Independent claim 1, as amended recited a combination wherein "the number of staple members are connected by adhering with the tearable film." In *Fujishima*, staples 10a are not connected by adhering with pulling out tape 12. In fact, pulling out tape 12 is wound only one round on the roll staple body. *Fujishima*, col. 2, ll. 21-23. Instead, the function of the pulling out tape 12 is to provide a means by which the leading end portion of the roll staple body 11 can be extended in a sheet shape. *Fujishima*, col. 3, l. 65 – col. 4, l. 10. Accordingly, pulling out tape 12 is not a tearable film as claimed.

Finally, *Lerner* fails to disclose a tearable film that "is adhered to a center portion of a staple member which does not constitute a leg after the staple member is formed." Instead, *Lerner* discloses an elastic tape F which adheres to the leg portions of staple elements SE. *See, e.g.*, *Lerner*, Figs. 5 and 6.

For at least the above reasons, the Final Office Action has failed to establish prima facie obviousness. Accordingly, Applicant respectfully requests the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Further, Applicant asserts that claims 2-9 are allowable at least because of their respective dependencies from independent claim 1, as amended, and the reasons set forth above.

CONCLUSION

In view of the foregoing, Applicant respectfully requests entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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